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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,858	08/15/2000	Goran Rune	2380-163	1139

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Nixon & Vanderhye PC
1100 North Glebe Road
8th Floor
Arlington, VA 22201

EXAMINER

SCHULTZ, WILLIAM C

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,858

Applicant(s)

RUNE, GORAN

Examiner

William C. Schultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant points to page 7 lines 2-17 and 24-30 but nothing in the original disclosure supports a "low activity state" as claimed by applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5 are rejected under 35 U.S.C. 102(e) as being anticipated by Schon et al. [U.S. Pat. 6,131,030].

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Regarding claim 1, Schon et al. discloses a radio access network comprising:

plural radio network controllers including a first radio network controller, the plural radio network controllers being situated to establish one or more overlapping routing areas, each overlapping routing area comprising a cell controlled by the first radio network controller and at least one cell controlled by another of the plural radio network controllers;

wherein for signaling the first radio network controller need only store network addresses for:

any of the plural radio network controllers which controls a cell in any overlapping routing area; and **(col. 5, lines 10-15 – RNC's 205 and 215 are in overlapping routing area 200)**

any of the plural radio network controllers which functions as a serving radio network controller for a connection for which the first radio network controller functions as a drift radio network controller. **(col. 5, lines 10-15 – RNC's 205 and 215 are drift RNC's for RNC 210; col. 4, lines 19-22 – functional definition of drift RNC)**

Regarding claim 3, Schon et al. discloses a radio network controller for a radio access telecommunications network which uses, as criteria for which other radio network controllers to store addresses, only:

those other radio network controllers which controls cells in overlapping routing area(s), the overlapping routing area(s) also having at least one cell

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controlled by the radio network controller; and **(fig. 2; col. 5, lines 10-15 – RNC's 205 and 215 are in overlapping routing area 200)**

those other radio network controllers which function as a serving radio network controller for a connection for which the radio network controller functions as a drift radio network controller. **(col. 5, lines 10-15 – RNC's 205 and 215 are drift RNC's for RNC 210; col. 4, lines 19-22 – functional definition of drift RNC)**

Regarding claim 5, Schon et al. discloses a method of operating a radio access network comprising:

providing plural radio network controllers; **(fig. 2, part 205,210,215)**

providing one or more overlapping routing areas, each overlapping routing area comprising a cell controlled by a first radio network controller and a cell controlled by another of the plural radio network controllers; **(fig. 2, part 200)**

regarding addresses of other radio network controllers in the radio access network, requiring the first radio network controller, for signaling purposes, only to store network addresses for:

any of the plural radio network controllers which controls a cell in the one or more overlapping routing area; **(col. 5, lines 10-15 – RNC's 205 and 215 are in overlapping routing area 200)**

any of the plural radio network controllers which functions as a serving radio network controller for a connection for which the first radio network controller functions as a drift radio network controller. **(col. 5, lines 10-15 –**

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**RNC's 205 and 215 are drift RNC's for RNC 210; col. 4, lines 19-22 –
functional definition of drift RNC)**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for
all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,4,6 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Schon et al [U.S. Pat. 6,131,030] as applied to claims 1,3,5 above, and
further in view of Tiedemann, Jr. et al. [U.S. Pat. 6,216,004].

Regarding claims 2,4,6, Schon discloses as above and further discloses
that IS-634 describes the messages makeup of performing the transfer of
identifies of neighboring cells but fails to disclose the signaling message
comprises both (1) an address of the first radio network controller, and (2) the
address of the second radio network controller,

Tiedemann, Jr. et al. discloses a cellular communication system with
common channel soft handoff wherein the first radio network controller sends, in
a signaling message to a serving radio network controller, both (1) an address of
the first radio network controller, **(col. 20, lines 52-57 – discloses the “from”
address)** and (2) the address of the second radio network controller, **(col. 21,
lines 13-22 – discloses the “to” address[es])**

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It would have been obvious for one skilled in the art to modify Lim with Tiedemann. The motivation for performing the handoff message, as Tiedemann discloses it, is to conform to the IS-95 specification and become compatible with cell phones in the market.

Response to Arguments

Applicant's arguments with respect to claims 1,3,5 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Schultz whose telephone number is 703-305-2367. The examiner can normally be reached on M-F(7-4)(first bi-week) M-Th(7-4)(second bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William Schultz



WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600